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In the Supreme Court of the United States

OCTOBER TERM 1957

No. 489

LESTER F. WILSON,
Petitioner,

vs.

MUENCH-KREUZER CANDLE CO., INC.,
Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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LESTER F. WILSON,
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Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

To the Honorable, the Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

The petitioner, Lester F. Wilson, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit. The judgment of the Court of Appeals reverses the judgment of the District Court, which had held petitioner's patent valid and infringed.

CITATIONS TO OPINIONS BELOW

No opinion was filed by the District Court. The opinion of the Court of Appeals (R. 397 to 403) is printed in the Appendix, pages 1 to 8 and is reported at 114 U. S. Patent Quarterly 203, ... F.2d .....

GROUNDS ON WHICH JURISDICTION IS INVOKED

The opinion and judgment of the United States Court of Appeals for the Ninth Circuit which this Court is requested to review was filed and entered on June 24, 1957. Jurisdiction is conferred upon this Court to review the judgment in question on a writ of certiorari by Title 28 of the United States Code, section 1254, subsection (1), the writ having been applied for within ninety (90) days of the judgment of the Court of Appeals.

QUESTIONS PRESENTED

1. When the Congress in 1952 enacted a statute, 35 U.S.C. 103, which, for the first time in the statutory law of patents set forth the requirement that a patentable invention must be unobvious and laid down as the test of obviousness that the subject matter of a patent must not "have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains", did the Congress mean to codify recent case law applying a more severe patentable standard of invention or did the Congress intend to codify older case law applying a less severe standard of invention?

2. Where an invention has been held by the Patent Office Board of Appeals and by the District Court to be patentable over the closest prior art patents; where respondent admits that the prior art considered by the Patent Office Board of Appeals is the most important prior art; and where the Court of Appeals concedes that such prior art fails to teach the patented invention, was it error for the Court of Appeals to hold the patent invalid for lack of invention because of assumed matters of fact, assumed to be common knowledge and of which the Court of Appeals took judicial notice?

3. Was it error for the Court of Appeals to disregard findings of fact made by the District Court based upon actual facts and

upon evidence in the case, and to substitute its own findings of fact based upon assumed facts and a hypothetical view of the prior art.

4. Should this Court, in the light of Congressional legislation and the criticism of judges and eminent laymen, reconsider the severe test of invention which it has adopted in recent years, and should it take into account the social policy urged by some of protecting new enterprises by a more liberal administration of the patent system?

STATUTE INVOLVED

The only statute involved is 35 U.S.C. § 103 which was enacted by Congress in 1952 as part of the new Patent Code, and which went into effect on January 1, 1953. This statute reads as follows:

> "Section 103. *Conditions for patentability; nonobvious subject matter*
>
> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE

This is a suit for patent infringement (Complaint, R. 3-5). Jurisdiction of the District Court was based upon 28 U.S.C. 1338(a) which confers on district courts "original jurisdiction of any civil action arising under any Act of Congress relating to patents" and upon 35 U.S.C. 281, "A patentee shall have remedy by civil action for infringement of his patent". Jurisdiction of the Court of Appeals is based on 28 U.S.C. 1291.

The patent (Wilson Patent No. 2,464,361, R. 328-330) is for an invention made by petitioner in the art of candle making. As will appear more fully hereinafter, petitioner built up a small but thriving business based on this invention which prospered a few years until respondent entered the field, imitated petitioner's product and all but drove petitioner out of business.

Two agencies of the Federal government passed favorably upon the quality of petitioner's invention before it was passed upon adversely by the Court of Appeals. The first such agency was the Board of Appeals of the Patent Office whose unreported opinion upholding the patentable quality of the invention is printed in the Appendix at pages 9 to 13. The second agency was the District Court which, after a trial, held the patent valid (R. 19, paragraph 1 of Judgment), thereby in effect affirming the holding of the Patent Office Board of Appeals.

The Court of Appeals reversed on the ground of lack of patentable invention (R. 403; Appendix, page 8). The Court of Appeals agreed that, as regards the prior art relied upon by the respondent at the trial,

> "appellee [petitioner here] has the better of the argument" (R. 402, Appendix, page 6)

The Court of Appeals also conceded that petitioner had excellent commercial vision and

> "Muench-Kreuzer [respondent here] took from Wilson [petitioner] what he had" (R. 403, Appendix, page 8)

However, the Court of Appeals felt constrained by

> "a number of Supreme Court cases which of recent years have tightened up the standards of patentability" (R. 402, Appendix, page 7)

and by asserted facts of common knowledge of which it took judicial notice, to hold the patent invalid as a matter of law.

The patent, as stated, relates to candle making. It is a drip candle, which is a candle designed to drip excessively while burning, thereby forming a mass of congealed drippings which have an esthetic appeal. The novelty and special appeal of petitioner's candle lies in the fact that, it not only drips, but it drips a succession of colors (e.g., red, then green, then yellow). Yet, from its outward appearance one cannot tell what colors the candles will drip. For example, the outward appearance of the candle may be white but it will drip first red, then green, then yellow, assuming that to be the succession of colors chosen by the manufacturer. The character of these candles is epitomized by petitioner's name for its candles (Magi-Color), by respondent's name for its candles (Make-a-Rainbow) and by respondent's advertising:

> "It's beautiful * * * astonishing the way these pure white candles melt in magic patterns of multicolored wax"

Also,

> "Entertaining soon? For a centerpiece sure to be a conversation piece, burn Rainbow Candles. Hear guests exclaim, then marvel as the brilliant colors emerge and blend" (R. 32, 33, identification of Plaintiff's Exhibit 12; R. 66, 67 for the quoted phrases)

Petitioner's preferred means of accomplishing this result (which is the identical means employed by respondent until September 5, 1952, Finding No. 11, R. 14, 15) was as follows: A wick is taken and is impregnated at intervals with a dye which is soluble in melted candle wax. For example, a segment of wick would be impregnated with a red dye, another with a green dye and a third segment with a yellow dye. Then a body of wax is built up around the impregnated wick, the body wax having a uniform color, e.g., white. As the candle burns, the dye will dissolve in the melting wax and will color the drippings, first red, then green and then yellow, if that is the color sequence from top to

bottom of the candle. Meanwhile the uniform body color conceals the interior colors and the viewer does not know what color will drip next.

Petitioner commenced selling his Magi-Color candles in accordance with his invention in 1945. Annual sales increased steadily, in round figures, from 42,000 candles in 1945 to 475,000 candles in 1951 (Plaintiff's Exhibit 15, R. 338; R. 56). Concurrently, petitioner's little business grew to a total personnel of eight (R. 56, 57). Respondent entered the field with its Make-a-Rainbow candles in 1949 (R. 103). These candles were admitted to infringe petitioner's patent (so admitted in respondent's Opening Brief on appeal to the Court of Appeals, at page 2). Respondent is one of the largest candle companies in the United States (R. 91); it and its predecessors have been in the candle business since 1910 (R. 90, 91); and Mr. Norbert Muench, vice-president of respondent (R. 90) and his ancestors have been in the candle business since 1867 (R. 114, 115). Although respondent is not large compared to Standard Oil or General Motors, it is very large compared to petitioner, having 200 employees and maintaining a part-time research laboratory (R. 92).

The impact of respondent's sale of Make-a-Rainbow candles was quick and disastrous; petitioner's sale of its Magi-Color candles slumped from 475,000 in 1951 to 190,000 in 1955 and its personnel dropped to three at the time of trial in March of 1956 (R. 56, 57; R. 338, Plaintiff's Exhibit 15).

In the Patent Office proceedings which led up to the granting of petitioner's patent, two references were cited, these being prior patents to Funke and Nelson (R. 330). The Board of Appeals sustained the patentable quality of petitioner's invention over these references (Appendix, pages 12, 13). At the trial, respondent's counsel admitted that the same Nelson patent considered by the Board of Appeals (a copy of which is at R. 348, 349) was

"The most important of the prior art patents." (R. 42)

This prior art related to coloring the flame of candles by using a metal salt.

The Court of Appeals agreed with the Patent Office Board of Appeals and with the District Court that these prior art flame coloring patents did not point the way to petitioner's invention and that as to such prior art

> "appellee [petitioner] has the better of the argument" R. 402; Appendix, page 6)

The Court of Appeals, however, took judicial notice of certain asserted facts. Evidently these asserted facts were unknown to the Patent Office Board of Appeals and to the District Court and, for that matter, to respondent's counsel; or, if these asserted facts were known to the Board of Appeals, to the District Court or to respondent's counsel no importance was attached to them. These asserted facts are:

> (a) "* * * the experience of children to stick a colored candle on top of one of another color, perhaps even to get successively colored drippings on a bottle * * *" (R. 401; Appendix, page 6)
>
> (b) "the old practice, particularly in candles for Christmas, of making a candle with two colors, say a white core and a red jacket." (R. 401; Appendix, page 6)

The Court of Appeals further assumed that all petitioner did was to combine "the experience of children" in putting one candle on top of another, vary the colors, use a single wick, and then put on a single colored jacket as in the case of the Christmas tree candles (R. 401; Appendix, page 6).

Notwithstanding this ingenious reasoning, the Court of Appeals might have held otherwise

> "Were it not for a number of Supreme Court cases which of recent years have tightened up the standards of patentability * * *" (R. 402, Appendix, page 7).

The Court of Appeals concluded with the regretful observation that

> "It seems clear enough that Muench-Kreuzer [respondent] took from Wilson [petitioner] what he had, but we have come to the conclusion that what Wilson had was in the public domain" (R. 403, Appendix, page 8).

ARGUMENT

1. An important question of statutory construction is involved which has caused widespread confusion among the lower courts.

The statute involved is 35 U.S.C. 103 which reads as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, *if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.* Patentability shall not be negatived by the manner in which the invention was made."

The portion emphasized by italics is the precise point involved.

The Reviser's Note states that no corresponding provision existed in the previous statutes. It is thus something new in the statutory law of patents. The Note continues that the Patent Office and Courts have applied a similar rule at least since 1850. Thus it is apparent that 35 U.S.C. 103 is a codification of pre-existing law, but the question remains, what pre-existing law?

This ambiguity is pointed out by the Reviser's Note that

> "This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect * * *"

It is implicit that the case law has been unstable.

Three cases will serve to illustrate the instability of the case law. Mr. Justice Jackson in a dissenting opinion in *Jungersen v.*

Ostby & Barton Co., 335 U.S. 560, 572, 93 L.Ed. 235, 242, said:

> "But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this Court for striking them down so that the only patent that is valid is one which this Court has not been able to get its hands on"

And, as noted by Mr. Justice Frankfurter at page 568 of the U. S. Report, although the patent was not one whose adjudication carried serious consequences for an important industry or the general public,

> "The case does, however, raise basic issues regarding the judiciary's role in our existing patent system"

In a more recent case, decided since 35 U.S.C. 103 was enacted, *Lyon v. Bausch & Lomb Optical Co.*, 224 F.2d 530, C.A. 2, 1955, Judge Learned Hand held that the patentee's contribution certainly would have been held patentable twenty or thirty years ago but that

> "On the other hand it must be owned that, had the case come up for decision within twenty, or perhaps, twenty-five years, before the Act of 1952 went into effect on January 1, 1953, it is almost certain that the claims would have been held invalid" (224 F.2d at page 535)

Judge Chambers in the case at bar, *Muench-Kreuzer Co. v. Wilson*, (R. 402, Appendix, page 7) observed that

> "Were it not for a number of Supreme Court cases which of recent years have tightened up the standards of patentability, we might hold otherwise"

The recent Supreme Court cases referred to by Judge Chambers all precede the effective date (January 1, 1953) of 35 U.S.C. 103.[1]

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1. *Mandel Brothers, Inc. v. Wallace*, 335 U.S. 291, 93 L.Ed. 12; *General Electric Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 90 L.Ed. 43; *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U.S. 327, 89 L.Ed. 1644; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 86 L.Ed. 58. The latest of these cases was decided in 1948.

Taking the most conservative view of 35 U.S.C. 103, to wit, that it was intended merely to stabilize the case law regarding patentable invention, the question remains undecided and in a state of confusion regarding what case law is stabilized. That is, is it the higher and more severe standard of invention of recent Supreme Court cases that has become the stable law, or is it the less severe standard of invention of older cases that has become the stable law.

As stated by an imminent scientist, Dr. Vannevar Bush in a Congressional study entitled "Some Proposals for Improving the Patent System" (page 15),

"We need, badly, freshly defined criteria of invention"[2]

2. There is a conflict among the circuits as to whether 35 U.S.C. 103 codifies the strict test of recent Supreme Court cases or the more lenient test of older Supreme Court Cases.

Obviously, the statute cannot codify both tests. Three views are entertained by the courts of the various circuits.

The view of the Second Circuit expressed in *Lyon v. Bausch & Lomb*, 224 F.2d 530, is that 35 U.S.C. 103 codifies the older more lenient test of invention, which was first enunciated by the Supreme Court in *Hotchkiss v. Greenwood*, 11 How. 248, 267, 13 L.Ed. 683. Subsequent cases in the Second Circuit leave no doubt that the rule of the *Lyon* case is as stated; i.e., that 35 U.S.C. 103 codifies the older, more lenient test.[3] The same view is shared by the Court of Appeals of the District of Columbia in

2. This publication, hereinafter referred to as the Bush Report, is available in the form of a Committee print and bears the caption "Proposals for Improving the Patent System. Study of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate, 84th Congress, Second Session, pursuant to S. Res. 167, Study No. 1."

3. *Gentzel v. Manning, etc. Inc.*, 230 F.2d 341; *Wilson Athletic Mfg. Co. v. Kennedy Spotting, etc. Co.*, 233 F.2d 380; *Welsh Mfg. Co. v. Sunware Products Co.*, 236 F.2d 225; *Magnus Harmonica Corp. v. Lapin Products*, 236 F.2d 285.

L.O.F Glass Fibers Co. v. Watson, 228 F.2d 40. At page 47 in footnote 14, this court observes:

> "We may safely assume that the Patent Act of 1952, 35 U.S.C.A. § 103, was intended to restore 'the law to what it was when the Court announced the definition of invention' ". (Citing *Lyon v. Bausch & Lomb*, supra)

The Eighth and Tenth Circuits are in a quandary and express no views as to which test of invention is codified by 35 U.S.C. 103. *Blish, etc. Co. v. Time Saver Tools*, 236 F.2d 913, 914, 915, C.A. 10, 1956. *Steffan v. Weber Heating etc. Co.*, 237 F.2d 601, 604, C.A. 8, 1956.

The Ninth Circuit in the case at bar clearly adopts the view that 35 U.S.C. 103 codifies the severe test of more recent U. S. Supreme Court cases. The opinion does not mention the statute specifically. However, it is indubitable that the Court of Appeals for the Ninth Circuit applies the severer test of the more recent cases. The present case is governed by 35 U.S.C. 103, and the Court of Appeals expressly holds that it is bound by

> "a number of Supreme Court cases which of recent years have tightened up the standards of patentability" (R. 402, Appendix, page 7)

3. The Court of Appeals in this case has departed materially from the accepted and usual course of judicial proceedings by disregarding the findings of the District Court based upon evidence in the record and by substituting new findings based upon personal experiences of the Court of Appeals.

Rule 52(a) of the Federal Rules of Civil Procedure provides that

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

Findings of fact were made by the District Court in the case at bar, that the prior art considered by the Patent Office (and con-

ceded by respondent to be the most important prior art) failed to teach petitioner's invention. These findings were made after a trial at which petitioner and the vice-president of respondent testified (R. 47 et seq. R. 90, et seq.).

The Court of Appeals did not hold that these findings were clearly erroneous. Instead, the Court of Appeals disregarded the findings of the District Court and adopted its own findings (such as "the experience of children", etc. and "the old practice, particularly in candles for Christmas", etc.). The new findings of the Court of Appeals are not taken from the evidence in the record but are taken from the personal experiences of the Judges of the Court of Appeals.

This procedure is so material a departure from the accepted course of judicial proceedings and is so violative of the above-quoted provisions of Rule 52(a) F.R.C.P. as to call for the supervisory authority of this Court.

4. This Court should consider the economic effects upon small business of a harsh, severe attitude toward patents.

This Court, ever conscious of the inroads of monopoly upon free enterprise, should look at the other side of the coin. In *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 92; 86 L.Ed. 58, 63, this Court cautioned that

> "Strict application of that test [the test of inventive genius] is necessary lest in the constant demand for new appliances the heavy hand of tribute be laid on each slight technological advance in the art."

This Court should ponder the effect in this case and in others like it of an overly zealous application of the strict test of invention. Here a small businessman who was more alert than his competitors, including larger, older and well entrenched competitors, produced an improvement which was different in structure and which accomplished a different result than anything

which preceded it. According to the Patent Office Board of Appeals, the District Court and even the Court of Appeals, this improvement differed materially from prior patents. This small businessman built up a thriving little business on the basis of his improvement. Then respondent, a much larger organization which had been in the business since 1910, "took from Wilson what he had".

Dr. Bush in the Bush Report, supra, argues forceably in favor of the patent system as a protection and incentive for investment and the creation of new business. He states at page 11 that expensive litigation:

> "is especially serious for the individual, or the small and struggling industrial unit, *for whom it is most important in the public interest that the full protection of the patent system be secured.*" (Emphasis added.)

And Dr. Bush further states that

> "Some of the responsibility for present conditions lies at the door of the courts themselves * * *"
> (pages 11 & 12)

He also states that (page 12):

> "The patent system functions best when unique devices or processes are independently protected by a single patent"

Such is the case here; a small free enterpriser bucking an old, well-entrenched, relatively large organization with only the shield of a single patent to help him survive. If the judgment of the Court of Appeals is permitted to stand, then petitioner and countless other alert, progressive small businessmen are doomed to extinction by large organizations who may under the law take what the small businessmen have and crush them by a preponderance of money.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

Respectfully submitted,

H. CALVIN WHITE
EDWARD B. GREGG
Attorneys for Petitioner

September 19, 1957

Certificate of Service

Pursuant to Rule 33, the above and foregoing Petition for Writ of Certiorari and Appendix thereto, have been served by depositing the same in a United States Post Office, with first class Air Mail postage prepaid, addressed to Lyon & Lyon, Counsel of Record for Respondent, at 811 West Seventh Street, Los Angeles 17, California, this 19th day of September, 1957.

H. CALVIN WHITE
EDWARD B. GREGG
Attorneys for Petitioner

(Appendix Follows)

Appendix

United States Court of Appeals
for the Ninth Circuit

No. 15,132—June 24, 1957

Muench-Kreuzer Candle Co., Inc., a corporation,
Appellant,

vs.

Lester F. Wilson,
Appellee.

On Appeal from the United States District Court for the Southern District of California, Central Division

Before: STEPHENS, CHAMBERS and BARNES, Circuit Judges

CHAMBERS, Circuit Judge:

OPINION

This is a patent suit involving Wilson's Magi-Color candle and Muench-Kreuzer's Make-a-Rainbow candle. Wilson holds patent No. 2,464,361 for Magi-Color.[1] The Make-a-Rainbow, which as it burns achieves the same result, is unpatented.

A little candle history is pertinent. Mention of candles is found in the Bible.[2] And their use has continued through the centuries. For many years in the modern era one of the objectives of candle makers has been to eliminate the dripping of wax as the candle burned. Finally, having achieved a virtually dripless candle, at

[1]The patent was issued March 15, 1949. The original filing was March 13, 1945.

[2]Book of Psalms 18:28; Matthew 5:15; Luke 15:8.

least dripless in the absence of wind, men turned about face, at least in the novelty field, and sought to achieve again the maximum drip or messiness attainable from a candle. A "dripper" is easily obtained by reducing the size of the wick in relation to the body of wax or by keeping the same wick and increasing the circumference of the surrounding wax. Too small a wick for the size of the body reduces the amount of capillary attraction of hot wax into the wick; thus the hot wax in the bowl under the flame cannot all be consumed in burning. So it runs or drips over the sides.

And into this trade of making dripping candles has come color. The underlying concept of the Wilson candle patented on March 15, 1949, and produced as Magi-Color, was a surprise package. There would be successive drippings of different colored waxes spilled over the side. Perhaps, red, then blue, then yellow, then green and then orange. If Wilson had simply piled a wide collar, band or ring of wax of one color after another around a wick from top to bottom, he could have achieved the Jacob's coat effect on the unburned candle and also again in the drippings when it was burned. But he wanted the surprise. So, in building a candle that was white on the outside, he put collars of wax in solution but in high concentration (called mother color or muetter farben in the trade) around the wick. These collars, after application, were well secreted from the exterior of the candle and not visible from the outside.[3] Sometimes the collars of color were contiguous to each other along the wick. At other times uncolored collars of wax separated those that were colored. Again there would be space on the wick between colored rings which was not filled in until the real body of the candle was made by adding the

[3]As an unused candle grows old there is a tendency for the dye placed within the candle to migrate or "bleed." Also, heat will expedite the bleeding. The bleeding may even reach the surface, thus destroy the candle's inside color secrets.

body wax[4] or candle stock for the body, either by dipping or molding. With this procedure worked out, Wilson applied for his patent. To get a patent at all, Wilson had to restrict his original claims and even then he had to carry it up to the Board of Appeals of the Patent Office. As a minimum, Wilson had a good timely commercial idea and at least one unlicensed competitor, Muench-Kreuzer, was quick to come out with a similarly constructed candle. Under threat of Wilson's claims of infringement, Muench-Kreuzer changed its production methods by adding two more steps to the process. It made a pencil sized taper with the wick inside of that. Then it painted at spaced intervals on the outside of the small taper bands or collars of mother color. Then with further dipping (or molding) the candle was built up to its normal size, the surprises hidden from the outside view.

We are not told how long the practice has obtained, but it is apparent that candles have been made for some time with a wax jacket of color which contrasted with the core of the candle. Also, there has been vertical striping or striping generally upward but following the pattern of rope cording or twisting.

With this preliminary matter stated, it is now appropriate to set forth the claims of Wilson as they were finally allowed:

"I claim:

"1. A drip candle comprising a wax-like body, different wax-soluble dyes normally concealed within the interior of the body at different locations longitudinally thereof and

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[4]The term wax in the opinion is not used specifically but generically. There are beeswax candles in the novelty field made by a rolling process. Tallow (and its modern derivative stearin or stearic acid) has long been a material used in the body of candles. Probably now the great source of the body material is found in some of the by-products obtained in the refining of petroleum. The great bulk of commercial candles is made in molds into which the wicks precede the body wax, called candle stock. The record here seems to point to the fact that the old process of dipping is common now, particularly in the novelty group. Perhaps both Magi-Color and Make-a-Rainbow were manufactured entirely by dipping. But if molding were used, there would be nothing in that which should affect our end result here.

normally undissolved in the wax of said body,[5] said dyes dissolving in the melted wax of the body to form multi-colored drippings as the candle progressively burns. (Emphasis supplied).

"2. A drip candle having a wax body and a wick containing a coloring material which dissolves in the wax as the candle burns to form drippings colored different from the normal exterior color of the candle.

"3. A drip candle having a wax body and a wick containing different coloring materials which dissolve in the wax as the candle burns to form multi-colored drippings.

"4. A drip candle having a wax body and a wick, spaced successive portions of which are impregnated with coloring material which dissolves in the wax as the candle progressively burns to color the drippings differently from the exterior color of the candle.

"5. A drip candle having a wax body, and a wick, successive portions of the wick being impregnated with different colored dyes which dissolve in the wax to produce multi-colored drippings as the candle progressively burns.

"6. A drip candle having a wax body and a wick, successive portions of which are impregnated alternately with wax and different colored dyes which dissolve in the wax to produce multi-colored drippings as the candle progressively burns."

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[5]What Wilson meant by "normally undissolved in the wax of said body" is a matter of some uncertainty. It would appear that his dye was ordinarily highly concentrated in a "wax." This wax perhaps had a higher boiling point than the regular candle stock or body wax with which the candle was built up. Strictly, a candle has apparently always consisted of two parts—the body and the wick. Thus, anything not in the wick ought to be considered body. But Wilson apparently in his mind excluded his aniline-in-wax, i.e. his mother color, from the term: body. What would he have meant by "abnormally dissolved?" This antithesis in his mind was probably the occurrence of bleeding. If he had thought of the eventual tactic that Muench-Kreuzer took to circumvent him, he probably would have thought that his claim covered the placing of the bands of color at an intermediate point as well as along the wick. Appellant has a very good argument that Wilson on this point is bound by file wrapper estoppel. Also,

If the claims are valid, Muench-Kreuzer, the defendant, (appellant here) clearly infringed the Wilson patent until September 5, 1952, when it modified its method by moving the mother color slightly away from the wick toward the periphery. When Wilson as plaintiff, now appellee, on March 6, 1953, brought this suit, patent infringement was admitted by the defendant until September, 1952, on condition the Wilson patent be found valid. After the change of September, 1952, Wilson can only stand on claim (1) for infringement. This he concedes. The district court found that Meunch-Kreuzer's Make-a-Rainbow under the modified method—colors around the slender taper instead of the wick—did infringe, as well as holding the whole patent valid with the consequent infringement of Meunch-Kreuzer prior to September, 1952, when Make-a-Rainbow was essentially a Chinese copy of Wilson's Magi-Color. The usual injunction and accounting were decreed.

On this appeal, according to our analysis, the judgment must be reversed and the Wilson patent declared invalid. After making due allowance for the proposition that all inventions once achieved are obvious once one understands the field and for the corollary that such "after-seen" obviousness does not blight patentability if the inventor really has something new, we believe that there is too little that is really new in Magi-Color to protect it.

Our reasoning is as follows:

1. Aniline dyes of one kind or another have been used commercially for over a hundred years. The Sterry British patent of 1871, a patent designed only to improve the color of a candle made with cheap paraffine,[6] speaks, in effect, of secreting aniline

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appellant thinks the natural construction of the quoted phrase limits the color to in or about the wick. What the words "normally undissolved in the wax of the body" mean is not herein decided.

[6]The color in the wick by light diffusion (apparently no migration of dye was involved) gave a different cast to the whole candle when viewed from without.

color in so much of the wick as is embedded within the wax, leaving the white ends of the wick exposed.

2. It is the experience of children to stick a colored candle on top of one of another color, perhaps even to get successively colored drippings on a bottle, a bottle being a candle holder of some antiquity. It may be assumed that putting a string of differently colored candles end to end on one wick would not be startling or considered a discovery or invention.

3. Closely related to (2) above, is the old practice, particularly in candles for Christmas, of making a candle with two colors, say a white core and a red jacket. This practice is surely in the public domain. Then if we follow the pattern of (2) above, put one short colored candle after another, vary the colors, on top of each other by the use of one wick, then put on a single colored jacket, we haven't arrested the thought of any candle maker or produced anything worthy of a patent.

4. Here in the Wilson Magi-Color candle we have someone for the first time who wants to market a candle with the element of surprise in the succession of colored drippings. This is achieved by hiding the aniline in concentrated form (mother color) in successive segments of the wick, by putting it concentrated in colors around the wick as Wilson does, or by putting it in bands around the thin taper as Meunch-Kreuzer now does.

5. There is some validity to appellee's argument that if we detour through the patents on surprise packages of successively colored flames in candles,[1] then in that "prior art," appellee has the better of the argument. We do not believe that these colored

[1]The execution of candles with colored or successively colored flames has never reached a state of high perfection. A metallic salt, there are many, is the key to coloring a flame different than the normal yellow. To get brilliant colors from these salts a hotter candle would be required than anyone wants to burn around a house. Also, there is a problem of clinkers forming as the candle burns.

flame patents necessarily pointed the way to the Jacob's coat in colored drippings.[8]

In sum, it is our judgment that the decision of the trial court on the evidence wherein it found invention in the Wilson patent was clearly erroneous.[9] Were it not for a number of Supreme Court cases which of recent years have tightened up the standards of patentability, we might hold otherwise.[10] We think there was no invention when appellant moved the collars of dye a little towards the outside shell of the candle and away from the wick. It is our best judgment that there was but little more original thinking in putting the collars in the wick or immediately around it.

We think that Meunch-Kreuzer with its unpatented Star-Pillar candle[11] had excellent commercial vision. And soon thereafter

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[8]Appellant has used one or two colored metallic salts in coloring the drip of candles. Only a few, particularly one or two in the copper family, are suitable to color drip. The home of the metallic salts is in the field of colored flames. (No opinion is expressed here on the validity of the colored flame patents.)

[9]There was very little, if any, conflict in the evidence. In this record, we have everything the district court had except the demeanor of the witnesses and what the district judge saw when some of the candles were burned. As the issues shaped up, we think that demeanor of witnesses and the burning demonstrations are unimportant to decision.

[10]Mandel Brothers, Inc. v. Wallace, 335 U.S. 291; General Electric Co. v. Jewel Incandescent Lamp Co. et al., 326 U.S. 242; Sinclair & Carroll Co., Inc. v. Interchemical Corp., 325 U.S. 327; Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84.

[11]Meunch-Kreuzer Star Pillar was first marketed in 1940. It is a dripper and had contrast. A cross section of it shows five points. In the center the candle was the usual wick and is surrounded by candle stock of a selected color, an ordinary candle having been made. But then instead of a plain jacket of contrasting color, a five-flanged jacket of a different color has been built around it; thus, the five pointed star. When burning, the drippings from the core run down the valleys formed by the flanges, making a sharp contrast with the outside wax.

Wilson had similar commercial judgment, when he foresaw that a surprise candle like his Magi-Color would sell in the current fashions of the candle market. Both had business daring. It seems clear enough that [illegible]ch-Kreuzer took from Wilson what he had, but we have come to the conclusion that what Wilson had was in the public domain.

Judgment reversed.

(Endorsed:) Opinion. Filed June 24, 1957.

PAUL P. O'BRIEN, *Clerk*.

United States Court of Appeals
for the Ninth Circuit

No. 15,132

Muench-Kreuzer Candle Co., Inc., a corporation,
Appellant,

vs.

Lester F. Wilson,
Appellee.

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, it is now here ordered and adjudged by this Court, that the judgment of the said District Court in this cause be, and hereby is reversed, with costs in favor of the appellant and against the appellee.

IT IS FURTHER ORDERED and adjudged by this Court, that the Appellant recover against the Appellee for its costs herein expended and have execution therefor.

(Endorsed) Judgment
Filed and entered: June 24, 1957

PAUL P. O'BRIEN, *Clerk*

Appendix

In the United States Patent Office

Appeal No. 17,938

Before the Board of Appeals

Ex parte Lester F. Wilson

Application for Patent filed March 13, 1945, Serial No. 582,572. Drip Candle.

Mr. H. Calvin White for appellant.

OPINION

This is an appeal from the action of the Primary Examiner rejecting claims 18 to 23, which are all of the claims in the application.

Claim 18 is illustrative and reads as follows:

18. A drip candle comprising a wax-like body, different wax-soluble dyes normally concealed within the interior of the body at different locations longitudinally thereof and normally undissolved in the wax of said body, said dyes dissolving in the melted wax of the body to form multi-colored drippings as the candle progressively burns.

The references relied on are:

Funke	1,701,844	Feb. 12, 1929
Nelson	1,908,044	May 9, 1933

The application discloses a "drip candle". The quoted phrase does not refer to a candle in which the molten wax completely burns at the exposed end of the wick in the way that it is usually desirable that a candle should operate, but instead to a

candle which drips some of the wax down along the outside of the candle body. The application refers to the "usual drip candle" as if such candles were made in some manner to assure dripping. The vast majority of candles are of the dripless type and the aim of their manufacturers is to make them as dripless as possible. Applicant provides a candle which is intended to drip and he provides means for assuring that the drippings are of a different color from the body of the candle. He also provides that the colors of the drippings from the various parts of the candle may be different. Thereby it appears that there may be produced an effect desired by applicant and one which might be considered ornamental. The coloring of the drip is secured by applying to various portions of the wick a stain or dye and it is emphasized that the body of the candle is not stained or dyed by this material but that the material is only stained or dyed as it is melted during the progressive burning down of the candle.

Applicant states that the Primary Examiner is endeavoring to make out an anticipation of the claims by the references but we do not find this in accordance with the Examiner's Statement, from which it is clear that the claims all stand rejected for lack of invention in view of the prior art.

In accordance with Sections 4886 and 4893 R.S., in order that a patent may issue for an alleged invention, it must be new, useful, involve invention and be sufficiently important.

We are of the opinion that the claims on appeal define novelty over the prior art cited by the Primary Examiner. The patents, as pointed out by the Primary Examiner, disclose candles in which the wick is treated with various chemicals for causing the flame to be of different colors. It also discloses the dyeing of the wax-like body of the candle with aniline dyes. Different parts of a candle body may be dyed with different colors. The prior art, however, does not disclose a candle in which normally undissolved

wax soluble dyes are contained within the body and therefore it is apparent that the claims recite a candle which is novel.

The Primary Examiner has not raised any question as to the utility or importance of the alleged invention and, although it is not too obvious why a candle which drips would be desirable, it may be considered of advantage to produce an interesting or ornamental effect by coloring the drippings and the grant of the cited patents indicate that the general subject matter is not so lacking in utility and importance to warrant refusal of a patent. This leaves for determination the question of whether or not the claims on appeal define invention.

It is the position of the Primary Examiner that, since the idea of using aniline dye to color a candle or various sections of a candle is old and the coating of the wick with the substance to produce a color of flame contrary to the color of the body is also old, no inventive thought would be required by one skilled in the art to locate the dye in the candle structure.

We do not find, however, any suggestion in the prior art of the treatment of a candle in any way which would produce a result disclosed by applicant. In view of the conclusion that the subject matter is useful and of sufficient importance and that the claims define a structure which is not anticipated by the prior art, it should be regarded as involving the element of invention, notwithstanding the simplicity of the inventive thought when once arrived at, and what appellant has done, judged by any standards announced by the courts is entitled to patent protection. *In re* Hubbell, 607 O.G. 575; 76 U.S.P.Q. 105.

The action of the Primary Examiner is reversed.

E. F. KLINGE
Examiner-in-Chief

H. H. JACOBS
Examiner-in-Chief

L. P. MCCANN
Examiner-in-Chief
Board of Appeals

December 27, 1948

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